

REMARKS

The last Office Action of May 27, 2009 has been carefully considered. Reconsideration of the instant application in view of the foregoing amendments and the following remarks is respectfully requested.

Claims 15-27 are pending in the application. Claims 15 and 23-27 have been amended. No claims have been canceled. No claims have been added. A total of 13 claims is now on file. An amendment to the specification has been made. No fee is due.

Claims 23-26 were objected to.

It is noted that claims 15-27 are rejected under 35 U.S.C. §112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

It is further noted that claims 15-27 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 15, 16, 18-25 and 27 stand rejected under 35 U.S.C. §102(b) as being anticipated by Japanese Pat. No. 200230098 to Tanimoto ("Tanimoto").

Claim 17 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Tanimoto U.S. Pat. No. to in view of U.S. Pat. No. to.

Claim 26 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Tanimoto in combination with U.S. Pat. No. 4,528,315 to Eck ("Eck").

OBJECTION TO THE SPECIFICATION

The Examiner required correction of certain spellings, which have been done by amendment. In view of the amendments, the objections have been obviated.

OBJECTION TO THE CLAIMS

The Examiner's objections to claims 23-26 have been avoided by correcting the terms as per the Examiner's request.

REJECTION OF CLAIMS 15-27 UNDER 35 U.S.C. §112, FIRST PARAGRAPH

The Examiner's rejection is respectfully traversed. The Examiner has determined lack of enablement for "ethylenic unsaturated monomers". As a first the Examiner recognizes the dispersoid polymers which are based on ethylenic unsaturated monomers as being enabled by listing such. The list encompasses polymers of great variety and divergence. Based on the list, the Examiner postulates that other ethylenic unsaturated monomers would not fulfill the required heat resistance and water stability. Applicant disagrees with this postulation. The listed polymers reveal great divergence among each other and there is thus no basis for the Examiner to state that undue experimentation is necessary to enable practicing the invention. Applicant further contends that it has disclosed a sufficient number of species so that claiming the genus of the ethylenic unsaturated monomers is warranted.

Furthermore, the Examiner recognizes the enablement for the dispersing agents as listed in the Office Action on page 6, also disclosed in [0015].

With respect to the "dispersing agent from a polyvinyl alcohol modified by ethylene units with an ethylene unit content below 20 Mol%". Similar to the postulation by the Examiner with respect to the ethylenic unsaturated monomers, while acknowledging a variety of disclosed agents, the Examiner rejects any extrapolation to a greater class of agents.

With respect to the feature "modified through ethylene units" it is pointed out that the specification [0016] it is amply described which ethylenic unsaturated monomers are useful for the modified polyvinyl alcohol. There it is specifically

stated that these chemically divergent monomers support the functional capacity of the adhesive.

With respect to the second feature, polyvinyl alcohol instead of ester hydrolysate, the specification in paragraph [0015] states that the modified polyvinyl alcohol is preferably realized through hydrolysis of a vinyl ester. The esters that are representative of different precursors which after hydrolysis always result in the same polyvinyl alcohol. Thus the recitation of the polyvinyl alcohol in the claim equals the hydrolysate of various ester precursors.

It is noted specifically that one of the important aspects of the invention is the addition of the polyvinyl alcohol, see also [0009] of the specification. The addition of the polyvinyl alcohol permits that the very different mixtures of dispersoid polymer and modified polyvinyl alcohol result in the improvement of rheological properties of the adhesive.

It is applicant's contention that based on the disclosure and the above remarks that the components of the adhesive are fully enabled for a person of ordinary skill in the art.

Withdrawal of the rejection of the claims 15-27 under 35 U.S.C. §112, first paragraph is thus respectfully requested.

REJECTION OF CLAIMS 15-27 UNDER 35 U.S.C. §112, SECOND PARAGRAPH

Applicant has amended claim 15 to replace watery with "aqueous" as proposed by the Examiner. The term "preferably" has been deleted. The term "aqueous" is synonymous with the term "watery" such that no new matter is being introduced.

With respect to the term "ethylenic units" applicant points to paragraphs [0015] to [0017] in the specification where it is described what the "ethylene units" are and how the modified polyvinyl alcohols are composed. Ethylene is the preferred co-monomer, however, ethylenic unsaturated monomers can also be

utilized for the modification of the polyvinyl alcohol.

The Examiner's rejection of the term "relative" is confusing since the term was used to clarify to which the percentages apply. It was found particularly important in claim 18, 22, 25 and 26 to refer with respect to the percentages to the entire dispersion.

Should the Examiner maintain the rejection, it is respectfully requested that another more apt term will be proposed.

Claims 23 and 24 were amended to avoid the rejection by the Examiner. In claim 26 the term "each" and the term "Mol" was deleted. In claim 27, the term "several" was replaced by "a plurality of".

It is believed that the various rejections have been overcome by the above amendments and discussion.

Withdrawal of the rejection of the claims 15-27 under 35 U.S.C. §112, second paragraph is thus respectfully requested.

REJECTION OF CLAIMS 15, 16, 18 - 25 AND 27 UNDER 35 U.S.C. §102(b) AS BEING ANTICIPATED BY TANIMOTO

The rejection under 35 U.S.C. 102(b) is respectfully traversed.

Tanimoto discloses a mixture of an aqueous emulsion of a dispersoid such as polyvinyl acetate, a dispersion agent representing a vinyl alcohol polymer and a nitrogen containing resin. The special feature in Tanimoto is the nitrogen containing resin. This compound is not a part of the claim adhesive. Furthermore Tanimoto does not disclose an adhesive in which a vinyl alcohol polymer is used together with a modified vinyl alcohol polymer. Rather, the modified vinyl alcohol polymer represents a preferred embodiment of the vinyl alcohol polymer.

The Examiner points to the Abstract with respect to the use of both, a vinyl alcohol polymer together with a modified vinyl alcohol polymer. However, in this manner, the Abstract exceeds the disclosure of the specification and is thus not

considered as prior art. Should the Examiner take the position that the Abstract acts separately as a prior art document, then applicant contends that the generic recitation of such facts do not amount to a disclosure of the claimed adhesive.

The Examiner's rejection is further confusing in that the Examiner points to Tanimoto claims 15, 16, 19-21, 23 24 and 26. However, The Tanimoto reference provided did not show any claims at all. A further reference JP, 2002-241411, A shows 3 claims. Applicant is at a loss to find the references the Examiner refers to. Clarification is respectfully requested.

It is furthermore submitted that none of the JP references disclose a pH value which is a criteria in claim 15. As such, the Tanimoto reference does not anticipate the claimed invention.

The Examiner's alternative rejection is on the ground of obviousness based on Tanimoto.

One of the objectives of the present invention is directed to the rheological properties and the high water resistance of the adhesive. In particular, as clearly set forth in the specification, use of the adhesive does not result in discoloring of the substrate such as for example wood. This is specifically due to the pH value as claimed.

There is nothing in Tanimoto that refers to the problem of discoloration of wood and to the pH. Thus it cannot be said that the claimed adhesive is anticipated by or rendered obvious in view of Tanimoto.

Withdrawal of the rejection of claims 15, 16, 18 - 25 and 27 under 35 U.S.C. §102(b) or 35 U.S.C. §103(a) is thus respectfully requested.

REJECTION OF CLAIM 26 UNDER 35 U.S.C. §103(a) AS BEING UNPATENTABLE OVER TANIMOTO IN VIEW OF ECK

The Examiner's rejection is respectfully traversed. The Examiner's refusals are confusing since the Examiner has not pointed out where in the

Tanimoto reference the various features are found or how the Tanimoto relates to the features in claim 26

Claim 26 recites a first saponified polymer and a second saponified polymer representing the viny alcohol polymer. The degree of polymerization and other criteria such as viscosity are also claimed. It is not seen where these features include the parameters of pH and Pas are found in Tanimoto.

The Examiner also cites Eck in combination with Tanimoto. While the Examiner states that Eck teaches use of the adhesive in the building sector, Eck does not teach nor disclose a particular pH which is the basis for applicant's results in producing a non-discoloring adhesive.

Withdrawal of the rejection of claim 26 under 35 U.S.C. §103(a) and allowance thereof are thus respectfully requested.

CITED REFERENCES

Applicant has also carefully scrutinized the further cited prior art and finds it without any relevance to the newly submitted claims. It is thus felt that no specific discussion thereof is necessary.

CONCLUSION

Applicant believes that when reconsidering the claims in the light of the above comments, the Examiner will agree that the invention is in no way properly met or anticipated or even suggested by any of the references however they are considered.


None of the references discloses an adhesive which has non-discoloring properties and the features as claimed.

In view of the above presented remarks and amendments, it is respectfully submitted that all claims on file should be considered patentably differentiated over the art and should be allowed.

Reconsideration and allowance of the present application are respectfully requested.

Should the Examiner consider necessary or desirable any formal changes anywhere in the specification, claims and/or drawing, then it is respectfully requested that such changes be made by Examiner's Amendment, if the Examiner feels this would facilitate passage of the case to issuance. If the Examiner feels that it might be helpful in advancing this case by calling the undersigned, applicant would greatly appreciate such a telephone interview.

Respectfully submitted,

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